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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,037	02/02/2004	Robert J. Rioux	BSCI-005/00US	7203

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EXAMINER

ROLLINS, ROSILAND STACIE

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,037

Applicant(s)

RIOUX ET AL.

Examiner

Rosiland S. Rollins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7-12, 15-17 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 13, 14 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/20/05; 2/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 13, 14, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Maguire et al. (US 2002019627). Regarding claim 1 Maguire et al. disclose an apparatus comprising: a catheter having a lumen (figures 19-31); a conductive element disposed along the catheter (paragraph 155); and a balloon (paragraph 155) having an interior in fluid communication with the lumen of the catheter, the balloon being formed of a conductive material conductively coupled to the conductive element (paragraph 170), the balloon having a collapsed configuration and an expanded configuration (paragraph 196). Regarding claim 2 Maguire et al. inherently disclose that the balloon in the expanded configuration having a size associated with a previously formed tissue cavity.

Regarding claim 13, Maguire et al. disclose, a method for operating a catheter and having a balloon in communication with the catheter comprising (paragraph 27): percutaneously disposing the balloon into a previously-formed tissue cavity while the balloon is in a collapsed configuration, the balloon being formed of a conductive material; expanding the balloon into an expanded configuration, the balloon in the expanded configuration having a shape associated with a shape of the previously-formed tissue cavity; and applying a radio-frequency signal to the conductive portion of

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the balloon. Regarding claim 14, Maguire et al. disclose circulating a fluid within the balloon, the fluid within the balloon having a temperature less than a temperature of the conductive material of the balloon (paragraph 136).

Regarding claim 18, Maguire et al. disclose an apparatus for treating a margin tissue associated with a tissue cavity after removal of a tissue mass (figure 26), comprising: a tubular member defining a lumen (156); and a balloon (570) having at least one electrode (552) and defining an interior in fluid communication with the lumen of the tubular member (paragraph 164), the balloon having a range of configurations including an expanded configuration corresponding to the tissue cavity and a collapsed configuration. Regarding claim 19, Maguire et al. illustrate that the at least one electrode of the balloon is formed with the balloon.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire et al. Maguire et al. teach all of the limitations of the claims except the conductive material of the balloon includes a plurality of conductive portions, two adjacent conductive portions from the plurality of conductive portions being separated by an insulation portion from a plurality of insulation portions, the conductive material is a first layer of balloon, the balloon further including a second layer and a third

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layer, the second layer of the balloon being formed of an insulation material, the third layer of the balloon being formed of a second conductive layer and the conductive material being a first layer of balloon, the balloon further including a second layer and a third layer, the second layer of the balloon being formed of an insulation material, the third layer of the balloon being formed of a second conductive material, the first layer and the third layer of the balloon each being a bipolar electrode. To have provided a plurality of conductive and insulative portions would have been obvious to one of ordinary skill in the art at the time the invention was made since it has been held mere duplication of essential working parts of a device involves only routine skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rosiland S Rollins
Primary Examiner
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